

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

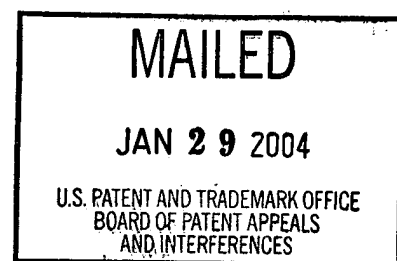
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAEED SHAFIYAN-RAD,
DANIEL M. CORBOSIERO, JR., and
MARK STEPHEN SCHLADENHAUFFEN

Appeal No. 2003-1511
Application No. 09/590,922

HEARD: January 21, 2004



Before KRASS, JERRY SMITH, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1- 5, 10-14, and 19-21. Claims 6-9 and 15-18 are objected to and would be allowable if rewritten in independent form.

We REVERSE.

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Appellants' invention relates to a multi-angle viewable indicator apparatus. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. An indicator apparatus, comprising:

a housing having a first side extending generally between second and third sides; and

at least one elongated strip of substantially translucent material extending through the first side and at least one of the second and third sides so that part of the strip is visible at the first side and the at least one of the second and third sides.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Keranen	3,711,699	Jan. 16, 1973
Piber	4,082,934	Apr. 4, 1978
Schneider et al. (Schneider)	Des. 391,182	Feb. 24, 1998

Claims 1, 2, 4, 5, 10, 11, 13, 14, 19 and 20 stand rejected under 35 U.S.C. § 102 as being anticipated by Piber. Claims 3 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Piber in view of Keranen. Claim 21 stands rejected under 35 U.S.C. § 103 as being unpatentable over Piber in view of Schneider.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 15, mailed Dec. 16, 2002) for the examiner's reasoning in support of

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the rejections, and to appellants' brief (Paper No. 14, filed Nov. 19, 2002) and reply brief (Paper No. 17, filed Feb. 24, 2003) for appellants' arguments there against.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 102

"Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention." **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). **See In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). After the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. **See In re Thorpe**, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); **In re King**, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, appellants' burden before the PTO is to prove that the applied

prior art reference does not perform the functions defined in the claims. Compare **In re Best**, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); **In re Ludtke**, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971). Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1. Here, we find that the examiner has not established a *prima facie* case of anticipation.

Appellants argue that Piber does not disclose "at least one elongated strip of substantially translucent material *extending through* the first side *and* at least one of the second and third sides so that part of the strip is visible at the first side and the at least one of the second and third sides" as recited in independent claim 1. (See brief at pages 4-5.) We agree with appellants that the teachings of Piber with respect to the insert that extends through a single end of a flattened tunnel does not extend through two sides of a housing so as to be visible from the at least two sides. Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims under 35 U.S.C. § 102. Independent claim 11 contains a similar limitation which is not taught by Piber alone. Therefore, we cannot sustain the rejection of independent claim 11 and its dependent claims under 35 U.S.C. § 102.

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